

Initially, it is noted that claim 1 was amended to incorporate the subject matter of canceled dependent claim 3. Thus, no additional subject matter is being claimed.

Independent claim 1 is directed to decorating a shoe by wetting a stick-on tattoo and applying the stick-on tattoo to a smooth outer surface of the shoe. It is noted that the foregoing technique often can provide a convenient way to decorate and redecorate a shoe. Independent claim 11 is directed to a decorated shoe with a stick-on tattoo attached to a smooth portion of the outer surface of the shoe. With regard to both of claims 1 and 11, the present inventor has discovered that applying a tattoo to a smooth outer surface of a shoe helps the tattoo adhere better and also facilitates later removal of the tattoo.

The applied art does not disclose or suggest applying a stick-on tattoo to a smooth outer surface of a shoe. Specifically, as acknowledged in the Office Action, Lehmann only suggests placing tattoos on hair, skin, clothing or toys. Nowhere, however, does Lehmann suggest applying a tattoo to a smooth outer surface of a shoe.

In view of this deficiency, it is asserted in the Office Action that "providing tattoos on different parts of the body and apparel is so old and conventional as to hardly require citation of a reference; Lehmann '765 is provided merely as an example of this common practice." However, as noted above, Lehmann says nothing about applying a tattoo to a shoe, but rather only mentions applying tattoos to hair, skin, clothing or toys. If, by the foregoing quotation, it is being asserted in the Office Action that placing a tattoo on a smooth outer surface of a shoe is well known in the art, then Applicant

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respectfully requests the Examiner to cite a reference showing this feature, as required by M.P.E.P. § 2144.03.

It is also noted that M.P.E.P. § 2142 requires that in order to establish a *prima facie* case of obviousness, the Examiner must cite prior art references that teach or suggest all of the claim limitations. In the present case, Lehmann clearly does not teach or suggest applying a tattoo to a smooth outer surface of a shoe.

Kellin has been reviewed in detail, but is not seen to supply what is missing from Lehmann in this regard. Specifically, Kellin is directed to articles of apparel in which substantially all exposed cloth surfaces are made of a stretchable "loop" fabric. See column 2, lines 60 to 62. As noted in Kellin, various articles of apparel can be utilized, such as a sneaker, slipper, baseball cap, a pair of suspenders, a belt or a backpack. However, each such article of apparel is required to be comprised primarily of an elastic cloth having a looped surface, thereby permitting decorative articles having a "hooked" backing to be applied to such apparel.

Thus, at most Kellin merely teaches that certain decorative articles of a specific type (i.e., those having a hooked backing) can be applied to different articles of apparel, provided that each such different article of apparel is comprised primarily of the same specific type of material (i.e., a looped material). More to the point, Kellin clearly does not teach that any arbitrary decorative article can be applied to any arbitrary type of shoe.

Kellin's teaching in this regard appears to be completely inapplicable with respect to the use of the tattoos described in Lehmann. In particular, Lehmann indicates that his tattoos can be applied to various different surfaces, i.e., clothing, skin,

hair or toys. This sharply contrasts with Kellin, in which specific decorative articles can only be applied to a specific type of fabric. Based on these differences, there would have been no motivation to combine Lehmann and Kellin in any manner whatsoever.

Finally, even if some permissible combination of Lehmann and Kellin teaches application of tattoos to shoes (and the above remarks clearly show that it cannot), nothing in any permissible combination of Lehmann and Kellin would have disclosed or suggested applying a tattoo to a smooth outer surface of a shoe. In this regard, the Office Action merely concludes that the location to place a tattoo on a shoe would be a design choice. However, most surfaces of typical shoes are not smooth, and nothing in Lehmann or Kellin suggests seeking out such a smooth surface. In particular, as noted above, Lehmann expresses no preference for any specific surface and Kellin, which in any event does not pertain to tattoos at all, only discusses a looped fabric surface.

Independent claims 1 and 11 are therefore believed to be allowable over the applied art.

Dependent claim 2 depends from claim 1 and recites the further limitation that the stick-on tattoo is comprised of a combination of a copolymer and a polyester resin. As to this claim, it is asserted in the Office Action that it would have been obvious to modify the material of the tattoos described in Lehmann as an obvious design choice or as a matter of routine optimization since it would appear that they would work equally well in any of a variety of sizes, shapes or materials. However, there is no support presented in the Office Action for this assertion. In particular, no reference has been cited to indicate that a tattoo comprised of a copolymer and a polyester resin would adhere well to hair or clothing, as discussed in Lehmann.

To the contrary, it is the inventor's experience that stick-on tattoos that are comprised of a combination of a copolymer and a polyester resin typically do not adhere well to such surfaces and, moreover, typically do not adhere well to ordinary base materials used for constructing shoes. However, the inventor has discovered that applying such a stick-on tattoo to a smooth outer surface of a shoe generally significantly improves adherence, while at the same time facilitating subsequent removal of the tattoo.

It is also noted that M.P.E.P. § 2143.01 provides, "If a proposed modification would render the prior art invention being modified unsatisfactory for its intended purpose, then there is no suggestion or motivation to make the proposed modification." Because using stick-on tattoos comprised of a combination of a copolymer and a polyester resin in Lehmann's device would have rendered his device unsatisfactory for its intended purpose, Lehmann clearly could not have suggested using such tattoos. For these additional reasons, claim 2 is believed to be allowable over the applied art.

Dependent claim 4 depends from claim 1 and recites the further limitation that the smooth portion of the outer surface of the shoe is comprised of polyvinyl chloride (PVC). Very few shoes have outer surfaces comprised of PVC. However, the present inventor has discovered that such a surface is particularly well suited to application of tattoos. As noted above, Lehmann is not very particular about to what surfaces his tattoos are applied, and certainly does not suggest applying them to an outer surface of a shoe comprised of PVC. Kellin says nothing at all about application of tattoos. Thus, no permissible combination of Lehmann and Kellin would have suggested seeking out a

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PVC surface on a shoe for applying stick-on tattoos. For these additional reasons, claim 4 is believed to be allowable over the applied art.

Dependent claims 6 and 7 depend from claim 1 and recite the further limitation that the stick-on tattoo is applied to a portion of the outer surface of the shoe that is white or clear, respectively. Initially, it is noted that relatively few shoes have outer surfaces that are clear or white. However, the present inventor has discovered that such colors often help to highlight the appearance of tattoos. Lehmann does not appear to specify any preferred color for the surfaces to which his tattoos are applied, and certainly does not suggest applying them to an outer surface of a shoe that is white or clear. Kellin says nothing at all about application of tattoos and, in any event, does not appear to prefer one color over another. Thus, no permissible combination of Lehmann and Kellin would have suggested seeking out a clear or white surface for application of a stick-on tattoo. For these additional reasons, claims 6 and 7 are believed to be allowable over the applied art.

Dependent claim 9 depends from claim 1 and recites the further limitation that the stick-on tattoo is comprised of a film-like material. Neither Lehmann nor Kellin discloses or suggests this feature of the invention. Instead, the Office Action merely concludes that it would have been obvious to modify the material of the tattoos described in Lehmann as an obvious design choice or as a matter of routine optimization since it would appear that they would work equally well in any of a variety of sizes, shapes or materials. However, there is no support in the Office Action for this assertion. In fact, there is no indication that a tattoo comprised of a film-like material ordinarily would adhere well to hair or clothing, as described in Lehmann.

To the contrary, it is the inventor's experience that stick-on tattoos that are comprised of a film-like material typically do not adhere well to such surfaces and, moreover, typically do not adhere well to ordinary base materials used for constructing shoes. However, the inventor has discovered that applying such a stick-on tattoo to a smooth outer surface of a shoe generally significantly improves adherence, while at the same time facilitating subsequent removal of the tattoo.

Because using stick-on tattoos comprised of a film-like material in Lehmann's device would have rendered his device unsatisfactory for its intended purpose, contrary to M.P.E.P. § 2143.01, Lehmann clearly could not have suggested using such tattoos. For these additional reasons, claim 9 is believed to be allowable over the applied art.

Dependent claim 10 depends from claim 1 and recites the further limitation that the stick-on tattoo does not include separate adhesive material and is applied to the shoe without using separate adhesive material. Lehmann's tattoos clearly use a separate adhesive backing (col. 3, line 4), and probably would not adhere to all the surfaces described in Lehmann without an adhesive backing. Accordingly, any such modification would have rendered Lehmann's tattoos unsatisfactory for their intended purpose, contrary to the requirements of M.P.E.P. § 2143.01. Lehmann therefore clearly could not have suggested using such tattoos. For these additional reasons, claim 10 is believed to be allowable over the applied art.

Dependent claim 12 depends from claim 11 and recites the further limitations that the shoe includes a recessed portion and that the smooth portion of the outer surface of the shoe is disposed within the recessed portion. A translation of Penataro has not been provided, and therefore the Office Action can only rely on the drawing

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provided in Penataro. That drawing shows a shoe that apparently has a strip attached along the bottom of its sole. The purpose of the strip is unclear, although presumably it is to protect the shoe.

In the Office Action, it is alleged that Penataro "teaches placing an ornamental strip in a recess with a smooth surface of the shoe." However, the drawing does not indicate that Penataro's strip is disposed within a recessed portion of the shoe or that the strip is attached to a smooth portion of the outer surface of the shoe, as in the present invention. Moreover, the Office Action has pointed to no other portion of Penataro that shows either of these features. Lehmann has been reviewed and also is not seen to disclose these features of the invention.

Also, even if Penataro had shown attaching a strip within a recessed portion of a shoe and to a smooth portion of the outer surface of the shoe (and it clearly does not), Penataro and Lehmann could not possibly have been combined as suggested in the Office Action. Specifically, Penataro's strip appears to be very narrow and would not seem to accommodate any of Lehmann's tattoos.

For these additional reasons, claims 12 to 14 are believed to be allowable over the applied art.

Dependent claim 15 depends from claim 11 and recites the further limitation that the smooth portion of the outer surface of the shoe is comprised of polyvinyl chloride (PVC). Initially, it is noted that very few shoes have outer surfaces comprised of PVC. However, the present inventor has discovered that such a surface is particularly well suited to application of tattoos. Penataro does not appear to say anything about to what type of surface his strip should be applied. As noted above, Lehmann is not very

particular about to what surfaces his tattoos are applied, and certainly does not suggest applying them to an outer surface of a shoe comprised of PVC. Thus, no permissible combination of Penataro and Lehmann would have suggested seeking out a PVC surface on a shoe for applying stick-on tattoos. For these additional reasons, claim 15 is believed to be allowable over the applied art.

Dependent claim 16 depends from claim 11 and recites the further limitation that the stick-on tattoo is comprised of a combination of a copolymer and a polyester resin. As to this claim, it is asserted in the Office Action that it would have been obvious to modify the material of the tattoos described in Lehmann as an obvious design choice or as a matter of routine optimization since it would appear that they would work equally well in any of a variety of sizes, shapes or materials. However, there is no support in the Office Action for this assertion. Penataro says nothing at all about tattoos. As to Lehmann, there is no indication that a tattoo comprised of a copolymer and a polyester resin ordinarily would adhere well to hair or clothing, as discussed in Lehmann.

To the contrary, it is the inventor's experience that stick-on tattoos that are comprised of a combination of a copolymer and a polyester resin typically do not adhere well to such surfaces and, moreover, typically do not adhere well to ordinary base materials used for constructing shoes. However, the inventor has discovered that applying such a stick-on tattoo to a smooth outer surface of a shoe generally significantly improves adherence, while at the same time facilitating subsequent removal of the tattoo.

Because using stick-on tattoos comprised of a combination of a copolymer and a polyester resin in Lehmann's device would have rendered his device unsatisfactory for

its intended purpose, contrary to M.P.E.P. § 2143.01, Lehmann clearly could not have suggested using such tattoos. For these additional reasons, claim 16 is believed to be allowable over the applied art.

Dependent claim 17 depends from claim 11 and recites the further limitation that the smooth portion of the outer surface of the shoe approximately matches the stick-on tattoo in size. As noted above, the applied art does not even disclose or suggest applying a stick-on tattoo to a smooth portion of the outer surface of a shoe. Accordingly, the applied art could not possibly have disclosed or suggested that such a smooth portion approximately matches the stick-on tattoo in size. For this additional reason, claim 17 is believed to be allowable over the applied art.

Dependent claim 19 depends from claim 11 and recites the further limitation that the stick-on tattoo is comprised of a film-like material. Neither Penataro nor Lehmann discloses or suggests this feature of the invention. However, the Office Action merely concludes that it would have been obvious to modify the material of the tattoos described in Lehmann as an obvious design choice or as a matter of routine optimization since it would appear that they would work equally well in any of a variety of sizes, shapes or materials. However, there is no support in the Office Action for this assertion. In this regard, Penataro says nothing at all about stick-on tattoos. Moreover, there is no indication that a tattoo comprised of a film-like material ordinarily would adhere well to hair or clothing, as described in Lehmann.

To the contrary, it is the inventor's experience that stick-on tattoos that are comprised of a film-like material typically do not adhere well to such surfaces and,

moreover, typically do not adhere well to ordinary base materials used for constructing shoes. However, the inventor has discovered that applying such a stick-on tattoo to a smooth outer surface of a shoe generally significantly improves adherence, while at the same time facilitating subsequent removal of the tattoo.

Because using stick-on tattoos comprised of a film-like material in Lehmann's device would have rendered his device unsatisfactory for its intended purpose, contrary to M.P.E.P. § 2143.01, Lehmann clearly could not have suggested using such tattoos. For these additional reasons, claim 19 is believed to be allowable over the applied art.

Dependent claim 20 depends from claim 11 and recites the further limitation that the stick-on tattoo does not include separate adhesive material and adheres to the shoe without use of separate adhesive material. In this regard, Penataro says nothing at all about stick-on tattoos. Lehmann's tattoos clearly use a separate adhesive backing (col. 3, line 4), and probably would not adhere to all the surfaces described in Lehmann without an adhesive backing. Because utilizing a stick-on tattoo that does not include separate adhesive material in Lehmann's device would have rendered his device unsatisfactory for its intended purpose, contrary to M.P.E.P. § 2143.01, Lehmann clearly could not have suggested using such tattoos. For these additional reasons, claim 20 is believed to be allowable over the applied art.

CONCLUSION

In view of the foregoing remarks, the entire application is believed to be in condition for allowance, and an indication to that effect is respectfully requested.

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Respectfully submitted,

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Dated: February 16, 2000

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